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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Regarding: Charles O. Townley
Serial No. 10/758,455
Filing Date 01/15/2004
Docket No. THUMB-604DIV
MODULAR BASAL THUMB JOINT IMPLANT

Request for Reconsideration of Prospective Objection

Attention: Group Art Unit 3738
Primary Examiner Brian E. Pellegrino

Commissioner for Patents
Post Office Box No. 1450
Alexandria, VA 22313-1450

I certify that this correspondence is deposited with the U.S. Postal Service in an envelope with sufficient postage addressed to the Office address, above on Feb. 6th, 2008:

Christopher John Rudy: Christopher John Rudy 2/6/2008.

Sir:

Please reconsider and withdraw the decision set forth on page 6 of the 08/02/2007 Office action to prospectively object to allowable claim 27 as being a substantial duplicate of allowed claim 38. That decision is respectively traversed.

The subject matter of claim 27 is not a substantial duplicate of claim 38. Thus, among other things, through its dependence on claims 22 and 21, claim 27 requires the following limitation as found in claim 21, lines 9-11:

"said articulating surface defines a truncated ball of a shape that is from substantially hemispherical to greater than substantially hemispherical."

Claim 38, on the other hand, requires the following limitation as found in lines 8-9 thereof:

"said articulating surface defines a truncated ball of a shape that is greater than hemispherical."

In other words, claim 27 includes a substantially hemispherical articulating surface, but claim 38 requires an articulating surface that is greater than hemispherical. And so, with respect to these limitations on their articulating surfaces as claimed, claim 27 is in substance more broad than claim 38.

A Brief for Appellant is submitted herewith.

Respectfully submitted,

Dated: Feb. 6, 2008 A.D.

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Brief for Appellant

Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450:

I certify that this correspondence is deposited with the U.S. Postal Service in an envelope with sufficient postage addressed to the Office address above on 6 FEB 2008:

Christopher John Rudy:

2/6/2008.

Please consider the present brief in support of the patentability of the claims on appeal. The required brief fee for a small entity of \$255.00 is submitted herewith (PTO-2038).

Real Party in Interest

The real party in interest is BioPro, Inc., Port Huron, MI.

Related Appeals and Interferences

Appeals in parent application No. 09/352,472, of which this is divisional, may have a bearing on this appeal. These are Nos. 2003-0155 dated March 13, 2003 and 2007-0570 dated June 14, 2007.

Status of Claims

Claims 1-20 have been canceled. Claims 21-42 are pending, with claims 38 and 39 allowed and claims 27, 30 and 33 allowable over the art of record. Claims 21-26, 28, 29, 31, 32, 34-37 and 40-42 stand rejected and are on the present appeal.

Status of Amendments

No amendment was filed subsequent to final rejection.

Summary of Claimed Subject Matter

The invention resides in a modular basal thumb joint implant (title, page 3, lines 2-3 and 13-22, page 6, line 6, page 7, lines 4 and 8-11; FIGS. 1-13 including 4-9, Nos. 10, 20 and 100). Generally, as found in both independent claims on appeal, claims 21 and 40, it includes a head of a size and having an articular surface for mounting and articulating with a correspondingly concavely prepared surface of trapezium bone stock, and a stem of a size for intramedullary insertion in metacarpal bone stock, with the head attachable to the stem (page 3, lines 16-22, page 7, lines 4 and 8-11, page 8, lines 1-4, 6-9, 12 and 14-15, page 9, lines 6 and 10-12, from page 9, line 20, to page 10, line 1; FIGS. 4-9 and 13, Nos. 9, 10, 20, 100). Claim 21 also requires

that the head have a single, smooth, generally hemispherical, medio-proximally directed articulating surface (page 3, lines 3-4, 14 and 16-17, page 7, lines 1-2 and 12-16, page 10, lines 9 and 12-13; FIGS. 1, 4-9, 13, Nos. 10, 11 and 31) and a generally abrupt, distally directed, planar end to the head which defines an end to the articulating surface and has a center (page 3, lines 5 and 18, page 7, lines 15-18, page 9, line 16; FIGS. 1-4, 7, 9-13, Nos. 10 and 12) with the articulating surface continuous as to its sphericity and uninterrupted up to the end of the articulating surface (page 3, lines 3-4, 14 and 16-17, page 7, lines 12-13 and 15, page 10, lines 9 and 12-13; FIGS. 1-4 and 9-13, Nos. 10, 11 and 31). Claim 21 also requires that the stem, when attached to the head, projects from the head along an axis, which arises from the generally planar end to the head (page 3, lines 6-7 and 14-16, page 8, lines 12 and 20-14; FIGS. 1, 4, 7, 9-10, 12-13, Nos. 12, 20 and 21) plus has feature(s) as follows:

- A) a general angle of projection from the head that is acute in relation to the generally planar end to the head (page 3, lines 7-9 and 14-16, page 8, lines 20-21; FIGS. 1, 4, 7, 10, 12 and 13, Nos. 12, 20 and 21);
- B) a flanged cross-sectional stem profile, which, when taken in cross-section perpendicularly to the stem, is in a tri-flange shape, with three flanges without notches extending distally on the stem (page 3, lines 10 and 14-16, from page 8, line 24 to page 9, line 3, page 9, lines 13-14, page 11, line 7, page 12, lines 6-7; FIGS. 1, 2, 4, 5, 7, 10, 12 and 13, Nos. 20, 21, 51, 58);
- C) an inwardly curved stem (page 3, lines 11 and 14-16, page 4, lines 4-13, page 9, lines 14-15; FIGS. 1, 4, 7, 10, 12 and 13, Nos. 10 and 20; and/or
- D) an eccentric head site for the stem, which is offset from the center of the generally planar end of the head (page 3, lines 12 and 14-16, page 4, lines 4-6, page 9, lines 15-16; FIGS. 1, 4, 12 and 13, Nos. 10 and 20).

Grounds of Rejection to Be Reviewed on Appeal

All issues for review fall under 35 USC 103(a) as follows:

1. Are not claims 21, 22, 25, 26, 28, 29, 40 and 41 patentable over McLaughlin, U.S. patent No. 5,507,818?
2. Is not claim 23 patentable over McLaughlin in view of Townley, U.S. patent No. 2,934,065?
3. Is not claim 24 patentable under over McLaughlin in view of Lane et al., U.S. patent No. 5,674,297?
4. Are not claims 31, 32 and 34-36 patentable over McLaughlin in view of Abouaf et al., U.S. patent No. 5,871,547?
5. Is not claim 37 patentable over McLaughlin in view of the Wright Medical Technology brochure of record for the Swanson Titanium Basal Thumb Implant?
6. Is not claim 42 patentable over McLaughlin in view of "ASTM, 1998," presumably ASTM F 1377-98?